UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY K. MICHELSON

Appeal 2007-3157
Application 08/354,450
Technology Center 3700

Decided: November 14, 2007

Before LORA M. GREEN, NANCY J. LINCK, and
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

A review of the application has revealed that the appeal is not ready for a decision on the merits. Accordingly, the application is being remanded to the Examiner for further action.

The Examiner objected to the amendment filed January 7, 2004, contending that it introduced new matter into the disclosure (Answer[1] 3).

[1] All references to the Answer are to the Examiner's Answer mailed July 1, 2005.

The Examiner specifically listed seven of the amendments to the Specification that presented new matter, and then rejected claims 29-300 under 35 U.S.C. § 112, first paragraph, as containing new matter (Answer 6).

In the discussion of the seven amendments, the Examiner referred to specific claims as "Examples" of claims that contained the objected to language. Thus, as to the first amendment, which was designated as "a)," the Examiner stated that the "claims recite 'said flexible member being in at least in part curved when said flexible member is in contact with the tissue' (claim 29 lines 10-11 for example)." (Answer 3.)

Appellant argues that "the features which the Examiner identified as not being adequately supported concern claims 29-59, 65, 66, 100-143, 145, 148-150, 183-185, 211-241, 245-247, and 293-300. The Examiner has not provided any rationale as to why claims 60-64, 67-99, 144, 146, 147, 151-182, 186-210, 242-244, and 248-292 are rejected under 35 U.S.C. § 112, first paragraph." (Br.[2] 13-14.)

The Examiner, in response, pointed to more examples of claims that contain the objected to language, such as claims 60, 144, 29-59, and 100-143 (Answer 15.)

The Board serves as a board of review, not a *de novo* examination tribunal. *See* 35 U.S.C. § 6(b) ("The [board] shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents."). The burden is on the Examiner to set forth a prima facie case of unpatentability. *See In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996).

[2] All references to the Brief are to the Appeal Brief dated April 20, 2005.

We are unable to review the rejection of claims 29-300 as the Examiner has not set forth reasons why each claim on appeal contains language that has been objected to as being new matter. After carefully reviewing the Examiner's Answer, as well as the Supplemental Examiner's Answer, we cannot find any statement of rejection that would appear to apply to claims 100-143, 176, 179-210 and 242-300. The Examiner needs to clearly state which claims contain the objected to subject matter, and explain why the subject matter of the rejected claims constitutes new matter.

The Examiner asserts that "a review of the . . . claims will reveal whether or not these claims contain the language the examiner is referring to." (Supplemental Answer 4.)[3] The burden is on the Examiner, however, to reject the claims, and it is not the responsibility of Appellant, nor the Board on Appeal, to determine which rejections apply to which claims.

Thus, upon return of the electronic file, the Examiner needs to explicitly state which claims contain the objected to language, and why the language constitutes new matter.

The Examiner also made a statement "[r]egarding claims 33, 105, 148, 183, 214, and 245, the same arguments above would apply here as well. It is not clear how much weight can be given the functional intended use claim language." (Answer 15.) It is unclear, however, which arguments are "the same arguments" the Examiner is referring to. The Examiner makes similar statements regarding claims 34, 65, 106, 149, 184, 215, and 246, claims 35, 66, 107, 150, 185, 216, and 247, claim 145, and claims 211-241 (Answer 15), and again it is unclear how the rejection applies to the claims based on the statements made by the Examiner.

[3] All references to the Supplemental Answer are to the Supplemental Examiner's Answer mailed December 1, 2005.

The Examiner also rejected claims 29-300 under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the Examiner:

> It is not clear what the metes and bounds of the claims are since the claim language noted above has no clear support in the specification as originally filed. For example, it is not clear how much weight can be given the language that the flexible member forms an acute angle relative to the longitudinal axis of the shaft since the device is not made that way. There is no disclosure for the flexible head member being formed at an acute angle to the shaft. The angle the flexible head makes with the shaft is dependent on how it is placed in the body.

(Answer 6-7.)

The rejection under second paragraph is merely a statement that the Examiner is unclear what weight to give the purported new matter, and does not state how the claims do not meet the requirements of 35 U.S.C. § 112, second paragraph. Moreover, it is unclear what claim or claims contain the language "that the flexible member forms an acute angle relative to the longitudinal axis of the shaft." Upon return of administrative file, if the Examiner maintains the rejection under 35 U.S.C. § 112, second paragraph, the Examiner needs to explicitly address each claim and explain why the claim does not meet the requirements of 35 U.S.C. § 112, second paragraph.

CONCLUSION

In summary, upon return of the electronic administrative file, the Examiner needs to explicitly state which claims contain the objected to language, and why the language constitutes new matter. The Examiner should also revisit the rejection under 35 U.S.C. § 112, second paragraph, and may also wish to reconsider the rejection of claims 29-300 under 35 U.S.C. § 112, second paragraph, in view of the comments above.

REMANDED

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